

Application/Control Number: 09/675,406
Art Unit: 2173

Docket No.: PALM-3506

REMARKS

Reconsideration and allowance are requested. Claims 1 - 25 are rejected. The claims are amended not to overcome the prior art references cited or for patentability. Many of the claim amendments above broaden the claim scope. These amendments are made for the purpose of clarifying the claim language and broadening the claims in some areas while maintaining limitations which render the claims patentable as set forth below.

Rejection of Claims 1 - 25 Under Section 103

The Examiner rejects claims 1 - 25 under section 103 as being unpatentable over U.S. Patent No. 6,516,202 to Hawkins et al. ("Hawkins et al.") in view of U.S. Patent No. 6,408,176 to Urs ("Urs"). Applicant traverses this rejection and submit that these claims are patentable over the combination of prior art.

Applicant first traverses the motivation or suggestion to combine these references. Hawkins et al. teach a computer system wherein a handheld device can receive a cellular portion for adding telephone capabilities to the handheld device. There is a hardware-based solution to the problem of handheld devices not having this capability.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the

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examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

The Examiner has not met the criteria necessary for a *prima facie* case of obviousness. As set forth above, Hawkins et al. focus on a hardware feature of the cellular portion being added to a handheld device. They already discuss in their patent how to handle missed phone calls and how to manage caller-related information. For example, Hawkins et al. already discuss using caller identify information to provide easier return calls to the caller. See col. 8, lines 9 - 31; col. 7, lines 36 - 46. The process of managing caller-related information to simplify how a user interacts with the phone features is already taught by Hawkins et al. Their invention is internally complete with this kind of information.

Urs teaches a method for initiating communication within a system wherein caller-related information, such as a telephone number in a voicemail, is obtained and extracted so that a user can easily return a call without having to manually input the caller's phone number. Similar features are already disclosed and discussed in Hawkins et al. There would be no motivation by one of skill in the art to extend or seek further disclosure outside of Hawkins et al. in that they already have almost identical features disclosed internally in the reference. In this regard, each reference is individually complete and functional within itself and therefore there is no reason or motivation to add or substitute features from Urs into Hawkins et al. Therefore, claims 1 - 25 are patentable and in condition for allowance.

In addition to there being no motivation or suggestion to combine the references, Applicant submits that even if combined, these references fail to teach each limitation of the claims. Regarding claim 1, Applicant notes that the Examiner has conceded that Hawkins et al. do not teach that a phone call is placed to a last entered phone number if digits are not received just before a dial signal is received from a call initiation button. Claim 1 recites the step of determining whether digits were received from the selectable interface just before the

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dial signal was received from the call initiation button. When the phone call is initiated in response to the dial signal, wherein the phone call is placed to a last entered phone number if digits were not received just before the dial signal was received from the call initiation button. The Examiner asserts that Urs teaches a method of initiating communication wherein the send button is used to initiate a return call "including a last entered number." See Urs, Col. 3, lines 51 - 67; col. 4, lines 1 - 21.

Applicant traverses the Examiner's analysis of the teachings of the prior art. From col. 3, line 51 to col. 4, line 21, Urs does not teach (1) determining whether digits were received from the selectable interface just before dial signal was received from the call initiation button; and (2) when the phone call is initiated in response to the dial signal, the phone call is placed to a last entered phone number if digits were not received just before the dial signal was received from the call initiation button. Specifically, col. 3, line 50 - line 65 discloses receiving caller-related information and then using that information to initiate a return call. The caller-related information is not the same as a "last entered phone number" as in claim 1. Col. 3, line 66 through col. 4, line 21 teach extracting and converting the caller-related information in real-time as a voice mail message is received. Again, information from a voice mail of a caller is taught as being used for initiating a return call. In this manner, Urs teaches that the benefit of his invention is that the recipient of the phone call does not have to remember or write down a phone number. Urs does not suggest or mention initiating a return call using a last number entered, however. In cols. 3 and 4, they are exclusively focused on information from a caller and ways of using that information to generate a return call.

In fact, Urs teaches away from the present invention because their approach removes the requirement for the user to dial a phone number manually. See, col. 4, lines 20 - 21. In claim 1, the last phone number entered is the dialed phone number. If Urs approach were used and applied, there would simply be no last entered phone number because phone

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numbers that are dialed are obtained from caller-related information and thus not entered via the selectable interface. Therefore, Applicant traverses the Examiner's conclusion that the combination of references teaches a "call-previously-entered-phone-number" feature where it is shown above that Urs does not discuss using a last number entered. For this reason, Applicant respectfully submits that inasmuch as the combination of Hawkins et al. and Urs fails to teach this limitation of claim 1, that claim 1 is patentable and in condition for allowance.

Claims 2 - 9 each depend from claim 1 and recite further limitations therefrom. Accordingly, inasmuch as the parent claim is patentable, Applicant submits that these dependent claims are patentable as well.

Claim 10 recites a portable computing device which includes a call initiate button that, when activated, initiates a phone call to a last entered number if digits were no received just before the call initiation button was activated. As discussed above, Urs teaches away from using a last number entered by teaching that its caller-related information approach removes the need for the user to manually enter numbers. Therefore, claim 10 is patentable over the combination of references for the same reasons set forth above for claim 1. Dependent claims 11 - 16 are therefore patentable as well.

Similarly, computer-readable medium claim 17 and its dependent claims 18 - 25 are patentable under the same reasoning in that this claim includes a similar limitation regarding using a last phone number entered.

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CONCLUSION

Having addressed the rejection of claims 1 - 25, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

The Commissioner is hereby authorized to charge any necessary fees (or credit any overpayments) associated with this communication and which may be required to Deposit Account No. 50-3102, referencing Attorney Docket No. PALM-3506.

Respectfully submitted,

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